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APPLICANT(S): RAVI, Ashoke et al.
SERIAL NO.: 10/608,142
FILED: June 30, 2003
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REMARKS

The present Amendment and Response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Favorable reconsideration and allowance of the application is respectfully requested.

Status of Claims

Claims 1, 3-11, 13-21 and 23-27 are pending in the application. Claims 1, 3-11, 13-21 and 23-27 have been rejected. Claims 1, 3-7, 9, 11, 13-17, 19, 21 and 24-27 have been amended to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The amendments to the claims add no new matter. Claims 8, 18 and 22 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

CLAIM REJECTIONS

35 U.S.C. § 103(a) Rejection over Holdaway in view of Hess and Treatch

In the Office Action, the Examiner rejected claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over US Patent Number 4,198,604 to Holdaway ("Holdaway") in view of US Patent Number 3,866,145 to Hess Jr. et al. ("Hess") and US Patent Number 4,802,235 to Treatch ("Treatch"). Applicants respectfully traverse the rejections of claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Holdaway in view of Hess and Treatch in view of the remarks that follow.

According to M.P.E.P. § 2142, in order to establish a *prima facie* case of obviousness, a combination of prior art references must teach or suggest all the claim limitations.

Without conceding the appropriateness of the Examiner's combination, Applicants respectfully submit that the combination of Holdaway, Hess and Treatch does not meet the

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requirements of an obviousness rejection, in that the combination fails to teach or suggest all the elements of the claimed invention.

Independent claims 1 and 11 recite, *inter alia*, "a tunable oscillator having a tuned output frequency comprising: a first oscillation path having a first amplifier and a first oscillation tank with a first free-running frequency; a second oscillation path having a second amplifier and a second oscillation tank with a second free-running frequency, the second oscillation path being connected in parallel to the first oscillation path; wherein the first amplifier and the second amplifier are controlled by a tuning voltage; and wherein the output frequency is tunable between the first free-running frequency and the second free-running frequency."

Independent claim 21 recites, *inter alia*, "tuning an output frequency of a tunable oscillator to a value between a first free-running frequency of a first oscillation tank and a second free-running frequency of a second oscillation tank, wherein tuning comprises: providing tuning voltage at a node connected between first and second oscillation paths of said oscillator, wherein the first oscillation path is parallel to the second path, wherein the first oscillation path includes a first amplifier and said first oscillation tank, and wherein the second oscillation path includes a second amplifier and said second oscillation tank; and controlling the first amplifier and the second amplifier by the tuning voltage."

Applicants respectfully submit that none of Holdaway, Hess or Treatch, alone or in combination, teach or suggest, at least the above cited elements of claims 1, 11, and 21.

Holdaway discloses "a system in a frequency tuned apparatus for canceling noise in oscillating signals, enabling the frequency to which the apparatus is tuned to be determined independently of the frequencies of the oscillating signals." (See Holdaway column 7 lines 45-49).

Holdaway is silent, however, in general as to the elements of claims 1, 11 and 21 discussed above.

Holdaway specifically states that "Oscillators 15, 17, 19 are tuned to different frequencies, each of which frequency bears a predetermined constant offset relationship to the fundamental frequency component of the input signal." (see Holdaway column 3 lines 20-23). Applicants respectfully submit that the three oscillators of Holdaway (one tuned to 280

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MHz, one tuned to 2.05-3.60 GHz and one tuned to 1753.6 MHz) cannot be considered to have a tuned output frequency of a tunable oscillator between a first free-running frequency of a first oscillation path and a second free-running frequency of a second oscillation path as suggested by the Examiner on page 2 of the Office Action.

Hess and Treach also lack the above described limitations of claims 1, 11 and 21.

Based on the discussion above, Applicants submit that Holdaway fails to teach, either expressly or inherently, all the elements of claims 1, 11, and 21. Accordingly, independent claims 1, 11, and 21 are allowable over Holdaway in view of Hess and Treach.

Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Holdaway in view of Hess and Treach in view of the remarks that follow.

35 U.S.C. § 103(a) Rejection over Holdaway Hess and Treach in view of Igarashi

In the Office Action, the Examiner rejected claims 3-10, 13-20 and 23-27 under 35 U.S.C. § 103(a) as being unpatentable over Holdaway in view of Hess and Treach and further in view of US Patent Number 5,950,143 to Igarashi et al. ("Igarashi"). Applicants respectfully traverse the rejections of claims 3-10, 13-20 and 23-27 under 35 U.S.C. § 103(a) as being unpatentable over Holdaway in view of Hess and Treach and further in view of Igarashi in view of the remarks that follow.

As discussed, claims 1, 11 and 21 are allowable over Holdaway in view of Hess and Treach. Each of claims 3-7, 9-10, 13-17, 19-20 and 23-27 depends directly or indirectly from one of independent claims 1, 11, and 21 and incorporates all the elements of the claim from which it depends. Igarashi does not cure the deficiencies of Holdaway, Hess or Treach. Therefore, it is respectfully submitted that claims 3-7, 9-10, 13-17, 19-20 and 23-27 are likewise patentable.

Claims 8, 18 and 22 have been cancelled and therefore the rejection of these claims is now moot.

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Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 3-10, 13-20 and 23-27 under 35 USC §103(a) over Holdaway in view of Hess and Treatch and further in view of Igarashi.

Conclusion

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Response and Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

No fees are believed to be due associated with this paper. However, if any such fees are due, please charge such fees to deposit account No. 50-3355.

Respectfully submitted,

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